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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,660	02/01/2001	Sagahiro Tahoe	723-1006	3512
27562	7590	12/14/2004	EXAMINER	
NIXON & VANDERHYE, P.C. 1100 N. GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201			COBURN, CORBETT B	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/774,660

Applicant(s)

TAHO ET AL.

Examiner

Corbett B. Coburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 37-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 40 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for emulating programs with backward compatibility modes, does not reasonably provide enablement for general substitution of characters not available in the selected game. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Many programs have backward compatibility modes. Version 2 of the game may use characters from version 1. But often there is no way to take a character from version 2 back to version 1. This is because the version 2 characters may be represented by different data structures or have code that is not recognized by the version 1 software. Applicant has failed to disclose a method of changing version 1 to recognize these new data structures or codes. To the extent that Applicant's invention is enabled, the claimed feature is inherent in the emulated software. Thus, any emulator that runs this software will have this backward compatibility feature.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 38 & 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims contain the limitations "several minutes" and "several seconds" respectively. The term "several" in claims 38 & 39 is a relative term which renders the claim indefinite. The term "several" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is impossible to determine how many minutes or seconds is intended by "several". Examiner interprets these limitations to mean, "some indeterminate period of time".

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-36 are rejected under 35 U.S.C. 102(b) as being anticipated by grok-mame and MAME.

MAME is the Multiple Arcade Machine Emulator. It is a program that was introduced in January 1997, and to date emulates approximately 5,000 arcade games on various computer platforms and under various operating systems. MAME is a command line program – the user types in the game to be played along with options in order to run the program. This might look something like this:

C:> MAME pacman -option1 -option2

This would run the pacman program on the host computer with the options specified. The MAME documentation clearly states that MAME emulates the arcade machine upon which pacman was originally played. MAME is described in references  $V_1 - W_2$ .

Grok-mame (described in reference  $U_1$ ) is a graphical user interface designed for use with the MAME program. It was last updated in January 1998. (See reference  $U_2$ .) It cannot run without the MAME program – they are in essence a single software package. Therefore, it is appropriate to consider grok-mame and MAME to be a single reference. Throughout this rejection this combination will be referred to as grok-mame.

**Claims 37:** Grok-mame teaches a game information storage medium (program) utilized for a first game machine having a first architecture (i.e., a pc), with at least one game program for a second game machine having a second architecture (i.e., the arcade machine) different from the first architecture of the first game machine. The game program has a game title (i.e., Omega Race, Pac Man, Space Panic, etc.). There is at least one emulator program, which emulates the second game machine in the first game machine to thereby, render the game program executable on the first game machine. The emulator program is associated to the game title of the game program. There is a game selection program for the first game machine and for displaying information indicative of a game title of the game program to be selected by a player (see grok-mame menu screen shot). The game information storage medium is utilized on the first game machine, the game selection program is executed to permit a player to select a game title, and, upon selection of the game title, the game program corresponding to the selected game title is

automatically executed using the emulator program as a result of the association between the game title and the emulator program. Clearly, a player may play the game as many times as he likes. Many games have a "Play again?" button. Thus the instructions are temporarily stored in memory of the first game machine for a predetermined period of time after a game-over condition results during execution of the game program using the emulator program. As pointed out, the player can play the game any number of times. This grok-mame has a replay program that enables the game instructions to be executed again at the option of the user within the period after the game-over condition.

**Claims 38 & 39:** Since grok-mame could stay in memory indefinitely, the instructions can remain in memory for some indeterminate period of time.

**Claim 40:** Grok-mame emulates a large number of programs. These include programs that display graphics data of a plurality of kinds of characters usable in a game and a character display/selection program which displays the respective characters prior to the execution of the game program so as to prompt a player to select a desired character out of the displayed characters; and a data replacement program which replaces the graphics data read-out by the emulator program with the graphics data of the character that has been selected by the player – i.e., the player may choose which character to play. Some of these programs may include a backward compatibility feature in which characters not available in the selected game (i.e., characters from earlier versions of the game) may be imported to the selected program.

**Claim 41:** The each game program has a game title. There are at least two game programs – about 5,000 at last count. The game selection program includes a program

which displays game titles of the at least two game programs so as to cause the player to select any one of the game titles, and at a time that the execution of the game program is started-up, the game program having the selected game title is automatically executed using the emulator program as a result of the association between the emulator program and the selected game title. (See grok-mame screen shot.)

**Claim 42:** The game selection program displays information indicative of the game titles of the game program for the first game machine and the game program for the second game machine so as to prompt a player to select any one of the game titles. (Screen shot) When a game title selected by the player is of the game program for the first game machine, the game program for the first game machine is directly executed, and when the game title selected by the player is of the game program for the second game machine, the game program for the second game machine is automatically executed using the emulation program as a result of the association of the emulator program and the selected game title. Note since all programs are run on the first game machine, all programs are “game programs for the first game machine” and are all directly executed. If Applicant intends to amend the claims to claim the concept of running games designed specifically for the first game machine and not designed for the second game machine without using the emulator, Applicant is referred to Mame32 (described in reference U<sub>3</sub>), which is made of record, but not relied upon for this rejection.

**Claim 43:** The emulator program includes at least two emulator programs which emulate at least two kinds of the second game machines having architectures different from each other and each of said emulator programs are associated with respective game

titles, and the game selection program starts execution of a game program for the second game machine of the selected game title based on the emulator program corresponding to the selected game title of the game program for the second game machine. Grok-mame emulates approximately 5,000 different types of arcade machines.

**Claim 44:** The emulator program includes at least two emulator programs which emulate the second game machine in at least two kinds of the first game machines having architectures different from each other and each of said emulator programs are associated with respective game titles, and the game selection program includes a program for starting execution of the game program for the second game machine based on the emulation program corresponding to the selected game title for a kind of the first game machine. Grok-mame runs on any system that can run the Unix or Linux operating systems. This includes computers from mainframes to personal computers.

**Claim 45:** The second game machine has a lesser processing capability than the first game machine. Arcade machines process one game. General purpose computers can perform many functions.

**Claim 46:** Grok-mame includes a preliminary program for outputting preliminary information indicative of an outline of a game according to the game program, wherein when a game title is provisionally selected, the game selection program executes the preliminary program associated with the provisionally-selected game title so as to output the preliminary information, and when the game title is formally selected, the game selection program starts execution of the game program of the formally-selected game title and execution of the emulator program which causes the game program to be



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executed in the first game machine. Highlighting a game title causes the "rating", "style" and "note" fields to appear. This is execution of a preliminary program for outputting preliminary information indicative of an outline of a game according to the game program.

***Response to Arguments***

7. Applicant's arguments are directed to the claims as amended and are addressed above.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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